



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/313,335	05/20/99	BLASZCZEC	M 6927.0001-01

QM12/1026
FINNEGAN HENDERSON FARABOW GARRETT
& DUNNER LLP
1300 I STREET NW
WASHINGTON DC 20005

EXAMINER	
ONEILL, M	
ART UNIT	PAPER NUMBER

3713 10
DATE MAILED: 10/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/313335

Applicant(s)

Walsh et al

Examiner

O'NEILL

Group Art Unit

3713

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on filing of revised appl.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 23 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 23 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

DETAILED ACTION

Reissue Applications

The offer to surrender is acknowledged. However, the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

There is no request to transfer drawings. Further, the drawings present in the application were objected to by the draftsman, see the PTO-948.

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The applicants state that the error is not including method claims. However, the originally filed application had method claims and after the first office action on merits said method claims were cancelled.

Claims 1 through 23 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,630,755, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 through 23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the soft count supervisor comprising a computer that "provides spread sheet type accounting of notes and coupons," see col. 3:36-37, does not reasonably provide enablement for the "soft count supervisor comprising a computer and a program for providing a spread sheet output" (see claims 8 and 19). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the invention commensurate in scope with these claims. The claimed recitation of the "soft count supervisor comprising a computer and a program for providing a spread sheet output" can be interpreted by one of ordinary skill in the art as a general computer with general spreadsheet application program, e.g. a Dell Dimension personal computer running the Microsoft Windows operating system with Microsoft Excel application program being run with Windows. A fair reading of the originally filed specification by one of ordinary skill in the art would give the understanding to one of ordinary skill in the art that the soft count supervisor is a specialty computer with specifically developed software that provides "spread sheet type accounting of notes and coupons."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 through 17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections and thus being interpreted as a mere listing of parts. See MPEP § 2172.01.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 through 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucero et al., U.S. Patent No. 4,072,930.

Lucero et al. discloses the soft count tracking system as broadly claimed which comprises: an identification adapter having a unique serial number, which is the portable transponder (54) having the ID code module, see col. 3:42-44; a currency note validator having a microcontroller, not shown in the game machine (40) however it is well-known in the art that game machines have validators to determine whether currency is counterfeit or not; a storage mechanism having an integral storage memory (46); and a soft counter supervisor comprising a computer (48). All of these component are in communication with each other, see the figures. Lucero et al. doesn't expressly disclose the computer having "a program for providing a spread

sheet output." However, Lucero et al. does disclose that the computer receives accounting data, see col. 4:59-61. Hence, Lucero et al. implicitly contains a program to handle such accounting data; otherwise it would be meaningless for the computer to receive such data. One of ordinary skill in the art understands that spread sheet output would be substantially similar as accounting data when referring auditing game machines. Therefore, one skilled in the art would find the claimed invention as obvious in conjunction with one's knowledge of auditing game machines.

Conclusion

Claims 1 through 7 and 18 through 23 are not rejected under prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 703-308-3484. The examiner can normally be reached on Monday through Thursday 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-1118. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MON

October 24, 2001

A handwritten signature in black ink, appearing to read "m O'Neill". The signature is fluid and cursive, with the first name "m" and last name "O'Neill" clearly distinguishable.

MICHAEL O'NEILL
PRIMARY EXAMINER

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number of any, if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.